

ESTTA Tracking number: **ESTTA438048**Filing date: **10/26/2011**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	THREE-D SPIRITS, INC.		
Entity	Corporation	Citizenship	California
Address	c/o Machat & Associates, P.C. 9107 Wilshire Blvd., Ste. 425 Beverly Hills, CA 90210 UNITED STATES		

Attorney information	Michael Machat Machat & Associates, P.C. 9107 Wilshire Blvd., Ste. 425 Beverly Hills, CA 90210 UNITED STATES michael@machatlaw.com Phone:310 860 1833
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Registrations Subject to Cancellation

Registration No	3501419	Registration date	09/16/2008
Registrant	VOODOO TIKI TEQUILA CORPORATION 2521 NE 46TH STREET LIGHTHOUSE POINT, FL 33064 UNITED STATES		

Goods/Services Subject to CancellationClass 033. First Use: 2001/12/31 First Use In Commerce: 2001/12/31
All goods and services in the class are cancelled, namely: Tequila**Grounds for Cancellation**


<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
Priority and likelihood of confusion		Trademark Act section 2(d)	
Registration No	3701053	Registration date	10/27/2009
Registrant	VOODOO TIKI TEQUILA CORPORATION 2521 NE 46TH STREET LIGHTHOUSE POINT, FL 33064 UNITED STATES		

Goods/Services Subject to CancellationClass 033. First Use: 2001/12/31 First Use In Commerce: 2001/12/31
All goods and services in the class are cancelled, namely: Tequila**Grounds for Cancellation**

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Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85224901	Application Date	01/24/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	VOODOO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2002/03/26 First Use In Commerce: 2002/03/26 Distilled Spirits; Spirits		

U.S. Registration No.	2703243	Application Date	05/01/2001
Registration Date	04/01/2003	Foreign Priority Date	NONE
Word Mark	REDRUM VODOO SPICED RUM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2002/03/26 First Use In Commerce: 2002/03/26 Distilled spirits, flavored rum		

Attachments	85224901#TMSN.jpeg (1 page)(bytes) VOODOO__Petition_to_CancelR.pdf (6 pages)(76870 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/MM/
Name	Michael Machat
Date	10/26/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark Registration Numbers 3701053 and 3501419
For the marks VOODOO TIKI and VOODOO TIKI TEQUILA and design, respectively
Dates registered October 27, 2009 and September 16, 2008, respectively

THREE-D SPIRITS, INC,)
)
)
Petitioner,)
)
v.)
)
VOODOO TIKI TEQUILA)
CORPORATION,)
)
Respondent.)
)
)

TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

PETITION TO CANCEL, UNDER 15 U.S.C. § 1064

Petitioner, THREE-D SPIRITS, INC, a California Corporation using an address of 9107 Wilshire Blvd., Suite 425, Beverly Hills, CA 90210, believes that it has been or will be damaged by Registration No. 3701053 and 3501419 and hereby Petitions to cancel same.

To the best of Petitioner's knowledge, the name and address of the current owner of the registrations is VOODOO TIKI TEQUILA CORPORATION, 2521 NE 46th Street, Lighthouse Point, Florida 33064.

Description of Respondent's registrations: a trademark application was filed on December 4, 2008, for VOODOO TIKI and another trademark application was filed on February 8, 2008, for VOODOO TIKI TEQUILA and design. Each of the marks subsequently registered under Section 1A on the Principal Register, in class 033 for Tequila.

The above-identified Petitioner believes that it will be damaged by the above-identified registrations, and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

GENERAL ALLEGATIONS

1. In early 2001, Petitioner THREE-D SPIRITS, INC created a spiced rum and gave it the name VOODOO. Since it was a spiced rum, Petitioner also called its rum VOODOO SPICED RUM. Since the rum was packaged in Petitioner's unique bottle it uses for its primary brand, REDRUM, Petitioner also called its rum REDRUM VOODOO SPICED RUM, and obtained a trademark registration for it, Trademark Registration Number 2703243, which has subsequently become incontestable after Petitioner's Section 15 & 8 Combined Declaration was accepted by the USPTO.

2. Petitioner's VOODOO RUM commonly became known as VOODOO RUM throughout the beverage industry and among consumers, even though the label contained the words REDRUM and SPICED RUM in small letters.

3. Upon information and belief, Donna DeCunzo-Taddeo and John Taddeo are the alter egos of Respondent VOODOO TIKI TEQUILA CORPORATION.

4. Upon information and belief, Respondent and/or Respondent's alter ego's the Taddeos first began to import and sell tequila in the United States branded with the word VOODOO no earlier than December 2006, and probably not before January 2007, approximately five or six years after the date Petitioner began selling its VOODOO SPICED RUM.

5. Subsequently, Petitioner's attorneys sent at least two cease and desist letters to both Donna Taddeo and John Taddeo's attorneys demanding that they cease and desist from using Petitioner's VOODOO mark. The Taddeos and Respondent ignored those letters and purposely choose to intentionally infringe upon Petitioner's VOODOO mark.

6. In order to appear legitimate, the Taddeos and Respondent fraudulently filed the applications for the marks Petitioner seeks herein to have canceled.

7. On or about January 24, 2011, Petitioner filed a trademark application for the mark VOODOO in International Class 33 and was assigned the serial number 85224901.

8. On or about April 27, 2011, the USPTO cited Respondents registrations as a bar to Petitioner obtaining a registration for the mark VOODOO.

9. Accordingly, Petitioner THREE-D SPIRITS, INC. now seeks to cancel US Registration Numbers 3701053 and 3501419 for the marks VOODOO TIKI and VOODOO TIKI TEQUILA and design, respectively on the grounds that each registration was procured by fraud and on the grounds that Petitioner's VOODOO mark has priority over Respondent's marks; that Respondent's marks are likely to cause consumers to mistakenly believe that Respondent's Voodoo brand is associated, or endorsed or emanates from the same source as Petitioner's VOODOO brand, or alternatively that Petitioner's VOODOO brand emanates from the same source as Respondent's tequila.

FRAUD

10. Each of Respondent's registrations was obtained fraudulently in that as part of the formal application papers filed by respondent, respondent was required to declare that "no other person to the best of his knowledge and belief, has the right to use a confusingly similar mark in United States commerce. That statement, made in connection with each registration, was made by an authorized agent of respondent with the knowledge and belief that the statements were false. Upon information and belief, Respondent knew that the rights to the VOODOO brand belonged to Petitioner. Respondent knew at the time it filed each declaration with the USPTO that it did not have the right to use the VOODOO mark.

11. Furthermore, Petitioner avers upon information and belief that Respondent's representative lied when it stated its date of first use of the mark in commerce was at least as early as December 31, 2001. Upon information and belief, Respondent's could not and did not import any tequila into the United States branded with the name VOODOO TIKI until at least 2006, if not 2007.

12. Each of the false statements was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant Respondent a registration, and, reasonably relying upon the truth of Respondent's false statements, the U.S. Patent and Trademark Office did, in fact, grant two trademark registrations to respondent.

13. Petitioners have been damaged by Respondent's false statements and the registrations issued in reliance thereon in various ways, including that: (a) it will

interfere with Petitioner THREE-D SPIRIT, INC's efforts to market, distribute, promote and otherwise grow its VOODOO SPICED RUM brand; (b) it will interfere with the ability of Petitioner to obtain a registration for its VOODOO brand from the USPTO; and it will otherwise cause financial damage to Petitioner due to the likelihood of confusion between Petitioner's brand and Respondent's brand.

PRIORITY and LIKELIHOOD OF CONFUSION,

TRADEMARK ACT section 2(d)

14. Petitioner realleges each of the prior allegations made in paragraphs 1 through 13 hereof.

15. Petitioner alleges that Respondent's Registration Nos. 3701053 and 3501419 are confusingly similar to Petitioner's unregistered VOODOO mark (Trademark Application Serial Number 85224901) and to Petitioner's Registered Mark No. 2703243.

16. In each instance, the term VOODOO is so prominent and distinctive that purchasers would and/or do mistakenly believe that the goods come from a common source.

17. Petitioner Three-D Spirits, Inc began using the term VOODOO in connection with distilled spirits years before Respondent began using the same term in connection with tequila, and therefore has prior rights to the use of the term.

18. Respondent's marks are likely to cause consumers to mistakenly believe that Respondent's Voodoo Tiki mark and Voodoo Tiki Tequila mark and design is associated with, or endorsed by or emanates from the same source as Petitioner's VOODOO brand, or alternatively that Petitioner's VOODOO brand emanates from the same source as Respondent's tequila.

19. Petitioner has been damaged by Respondent's false statements and the registrations issued in reliance thereon in various ways, including that: (a) it will interfere with Petitioner THREE-D SPIRIT, INC's efforts to market, distribute, promote and otherwise grow its VOODOO brand; (b) it will interfere with the ability of Petitioner to obtain a registration for its VOODOO brand from the USPTO; and it will otherwise cause financial damage to Petitioner due to the likelihood of confusion between Petitioner's brand and Respondent's brand.

20. WHEREFORE, Petitioner prays that Registration Numbers 3701053 and 3501419 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

Dated: October 26, 2011

Respectfully submitted for Petitioner,

By:

_____/MM/_____
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